

***United States Court of Appeals  
for the Second Circuit***



**APPELLANT'S  
REPLY BRIEF**



74-1765

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**United States Court of Appeals  
FOR THE SECOND CIRCUIT**

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Appeal Docket No. 74-1765

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ESSO RESEARCH AND ENGINEERING COMPANY,  
*Plaintiff-Appellant,*

*v.*

KAHN AND COMPANY, INC. AND CHANDLER-EVANS, INC.,  
*Defendants-Appellees.*

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APPEAL FROM A JUDGMENT OF THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF CONNECTICUT

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**REPLY BRIEF FOR PLAINTIFF-APPELLANT**

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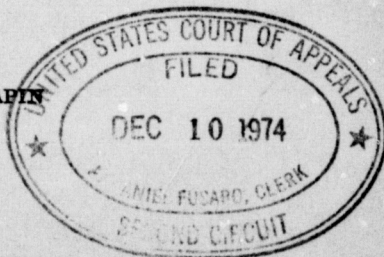
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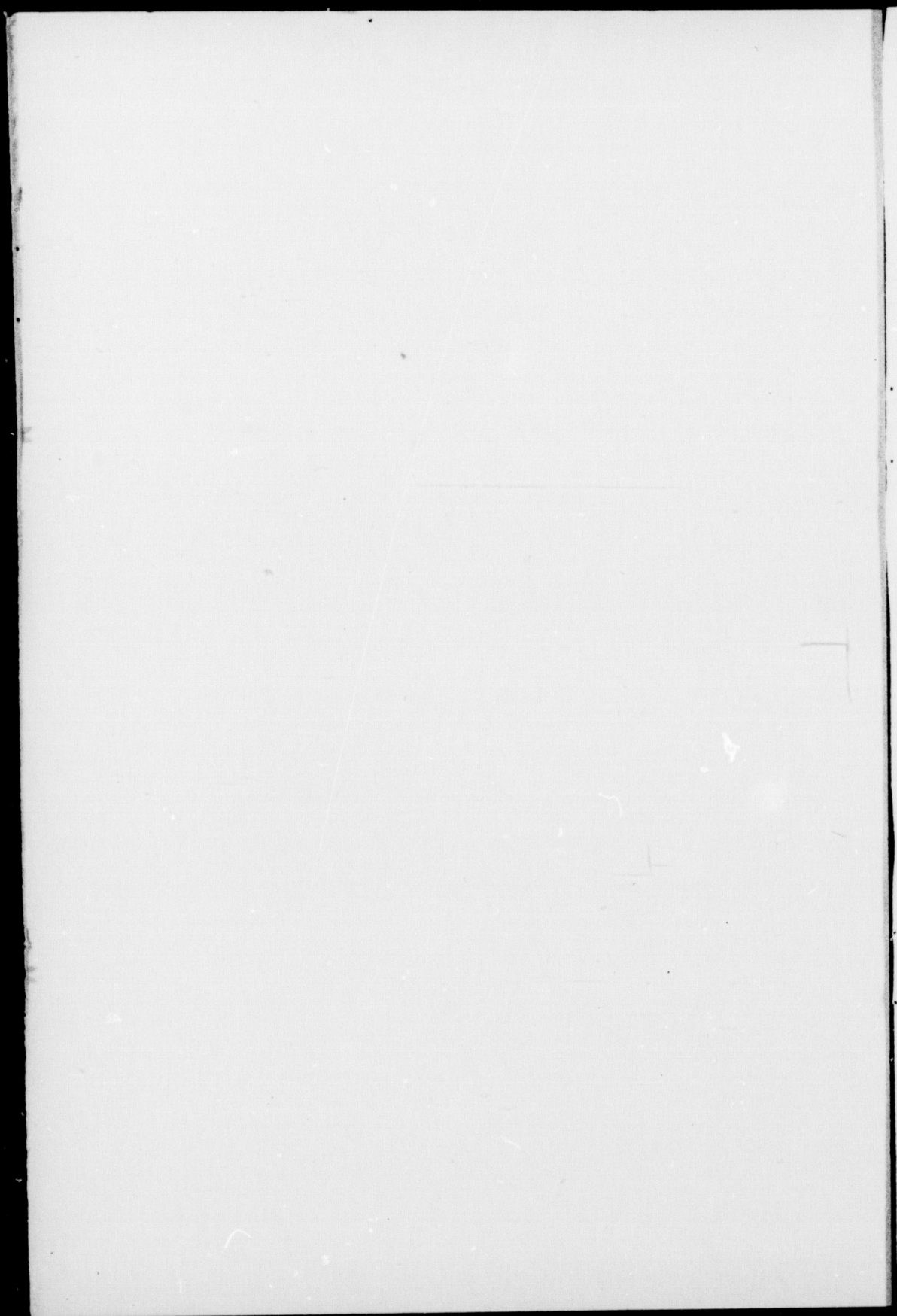
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Dated: November 1, 1974

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## Abbreviations Used:

- App. — Joint Appendix
- PX — Plaintiff's Exhibit
- DX — Defendants' Exhibit
- Pages preceded by E refer to the Exhibit Book.

**United States Court of Appeals  
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ESSO RESEARCH AND ENGINEERING COMPANY,  
*Plaintiff-Appellant,*  
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KAHN AND COMPANY, INC. AND CHANDLER-EVANS, INC.,  
*Defendants-Appellees.*

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APPEAL FROM A JUDGMENT OF THE UNITED STATES  
DISTRICT COURT FOR THE DISTRICT OF CONNECTICUT

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**REPLY BRIEF FOR PLAINTIFF-APPELLANT**

**Introduction**

Defendants-Appellees have filed a Brief on Appeal which hereinafter will be referred to as defendants' brief.

Before responding to defendants' brief in a more detailed manner, two points which appear throughout defendants' brief should be clarified for the purposes of logical thinking.

**(A) Kahle System Cannot be called a "heaterless drier"**

The terms "heaterless drying," "heaterless-type driers" or "heaterless drier" are used by defendants throughout their brief in a manner which causes confusion of thought

since defendants use these terms both to describe the Skarstrom invention and the prior Kahle art systems. This is clearly inaccurate.

First, as will be later further discussed, *none* of the Kahle references relied on was concerned with drying of air, much less a self-contained system. Rather, Kahle was concerned with removal of trace quantities of carbon dioxide from air to be fed to an air liquefaction plant, and used an adsorber system integrated with the liquid air plant for such separation of carbon dioxide. To call a carbon dioxide removal zone a "heaterless drier" is a perversion of the reference disclosure as well as the English language.

Secondly, if these Kahle systems and the Skarstrom process were one and the same thing, the lower Court would have ruled that the present invention was unpatentable under 35 U.S.C. § 102 for having been fully shown in a reference disclosure. The fact that this entire case relates to the question of obviousness under 35 U.S.C. § 103 is an acknowledgment by all parties, i.e., the lower Court, plaintiff and defendants, that the Skarstrom *combination* of features is novel (not present in Kahle).

Accordingly, both the Skarstrom invention and prior art cannot simultaneously be described as "heaterless drying" as appears throughout defendants' brief. The Skarstrom invention requires the combination of features referred to on pages 13 and 14 of plaintiff's brief and reiterated on pages 7 and 8 of defendants' brief, and is not merely any adsorption system or any drier which does not use a heater.

**(B) Defendants' brief repeats Trial Court's error  
as to piecemeal identification of steps**

A goodly percentage of defendants' brief appears to be a replay of the error made by the Trial Court, namely, seeking to reduce the present invention to a single one or

two features and then attempting to find these one or two features in one or more of the prior art references. Since as indicated in plaintiff's brief, plaintiff submits that invention resides in a combination of individually known elements, the piecemeal identification of individual steps certainly does not address the key question of whether the combination of features was unobvious and/or gives unexpected results.

Responding to specific points raised in defendants' brief, for the sake of good order, defendants' comments will be discussed under the main argument headings used in plaintiff's brief.

## **POINT I**

### **The Trial Court Failed to Recognize the Key Issue that a Combination of Known Elements Can be Patentable.**

#### **A. The Trial Court's Opinion Never Addressed Key Issue**

In spite of the comments on pages 2, 15 and 16 of defendants' brief, the lower Court at no time acknowledged that patentability was possible even though the elements of a combination may individually be known. At no time did the Trial Court set forth or test the proposition that assuming each of the individual elements were known, was there nevertheless an unobvious combination such as to give rise to invention. If the Trial Court had so considered the matter, it would have been a simple matter to clearly and unequivocally so indicate same in its decision.

Rather, the lower Court's opinion goes to considerable efforts to try and dissect the Skarstrom invention as residing in one or more purported novel features, which the Trial Court then seeks to individually find and isolate in the prior art.

This is the whole import of the lower Court's use of the German claim in opposition, i.e., an attempt to narrow the issue of patentability to determining whether or not one or more specific features are novel. For this same purpose, the Court attempted to reduce the Skarstrom invention to the four steps recited on page 11 of the decision (App. 48a) and then sought to find each individual step in a reference.

The Trial Court cites various cases in its opinion but utilizes none of them to either confirm the *basic* concept of patent law that a combination of individually known steps can be patentable, nor to test the facts of the instant case against this principle.

It is noteworthy that the section of the lower Court's opinion entitled "*Nonobviousness*" (App. 57a et seq) again illustrates the Trial Court's frame of mind in seeking to reduce the invention to one or two possibly novel specific features rather than seek to test whether a combination of individually known features was patentable.

This error is repeated on pages 8 to 10 of defendants' brief. Plaintiff does not contend that the individual steps shown on pages 7 and 8 of defendants' brief<sup>1</sup> in various colors are, per se, new. Indeed, the table presented in plaintiff's brief on page 26, as well as the testimony by both plaintiff's expert Professor Meissner and the inventor Dr. Skarstrom, freely admitted that the prior art heater-type drier was a cyclic adsorption system utilizing high and low pressure, and that a *small* portion of the dry product was used as a sweep to remove water which had been baked

1. The four steps on page 8 do not accurately reflect the total combination of features set forth on page 7. It neglects that the unit is self-contained (no external purge gas, heat exchangers, etc.).

out by high temperature heating.<sup>1</sup> However, this is not tantamount to the Skarstrom invention, but rather the unit which broke down and spurred Dr. Skarstrom's discovery. Indeed, it was the very people who manufactured and/or used the heated-type drier who were most surprised by the Skarstrom invention, and its ability to obtain super-dry air. Many of plaintiff's licensees are precisely the people who manufactured heated-type driers.

Since novelty is not urged for any one specific step but rather a combination of steps (each of which, per se, may be found in a reference), defendants' brief (pages 8 to 21) does no more than repeat the lower Court's error of seeking to test invention based on the novelty of any particular step.

The only quotation defendants could find in the lower Court's opinion confirming that it specifically addressed the foregoing key issue in this case was the general quotation appearing on pages 14 and 15 of the decision (App. 51a) from *Graham v. John Deere Company*, 383 U.S. 1 (1966) as to whether "the subject matter as a whole" was unobvious. The *Graham* case<sup>2</sup> however did not specifically deal with the issue of a combination of steps individually appearing in several references, and the quotation is merely a generalized restatement of what 35 U.S.C. § 103 requires to be patentable. The great effort that the lower Court went to in trying to isolate and find each individual feature of the Skarstrom invention in the art clearly shows it failed

1. Contrary to page 10 of defendants' brief, Dr. Skarstrom did not "merely cut off the heaters and speeded up the timing." As indicated on page 8 of plaintiff's brief, his testimony was that in order to reach his desired purge volume eight times larger than the heater-type unit, he had to change to a much larger valve (App. 207a and 208a) and made other changes to ensure equal flow at the high purge flow rate (App. 209a).

2. The Supreme Court found the *Graham* patent to be obvious over the structure of a single reference, the Glencoe patent, 383 U.S. 22 to 26.

to address the key issue of patentability, an unobvious combination of individually known steps.

**B. Prior Art, Freely Acknowledged by Plaintiff, Does Not Anticipate Skarstrom Invention**

As to plaintiff's knowledge of the Kahle references (page 11 of defendants' brief), certainly there is no dispute. Indeed, several of the Kahle patents were acknowledged by both plaintiff and defendant Kahn and Company in 1961 (App. 277a). While Kahle German Patents 871,886 (PX 5B, p. E-23); 970,223 (PX 5D, p. E-47) and the Kahle 1953 article (PX 5F, p. E-67) were recognized in the 1965 correspondence between plaintiff's United States patent attorney and its German patent agent relative to prosecution of plaintiff's corresponding application in Germany, defendants' brief conveniently omits the simple facts that:

(1) The comparative table on page 12 of defendants' brief (prepared in 1965) was not an admission of unpatentability, but rather quite the opposite. Even after giving the Kahle references their most damaging interpretation, plaintiff's June 11, 1965 letter (DX V(5), pp. E-203—E-211) reiterated plaintiff's position that the "combination of steps *even broadly* is not available in the prior art" (even if it is assumed that the tabular presentation was correct).<sup>1</sup>

As set forth on page 39 of plaintiff's brief, the above was plaintiff's position in 1964 (with respect to Germany); was plaintiff's position in its initial meeting with defendant Kahn and Company in 1961 (Smolka's memo of Kahn meeting, App. 279a), and is plaintiff's position today.

(2) The Kahle references set forth in the 1965 tabular comparison were before the German Patent Office when the application was pending in 1965. This application was thereafter *allowed* by the German Patent Office over these

1. See pages 38 and 39 of the plaintiff's brief.

very same references some three years later.<sup>1</sup> Accordingly, both the agent and the German Patent Office evidently found inventive subject matter *after* the 1965 correspondence.

(3) None of the Kahle references relied upon (pages 10 to 13 of defendants' brief), namely German Patent 871, 886 (PX 5B), 970, 223 (PX 5D) and the 1953 Chemie Ingenieur article (PX 5F) are drier systems. All are primarily concerned with removing carbon dioxide from the feed air to an air liquefaction process.

(4) The 1953 Kahle article, which summarizes his work and refers to German Patents 871, 886 and 970, 223 clarifies the systems relied on by defendants as anticipating Skarstrom's self-contained heaterless drier as the Sorbogen Process "whereby adsorbers are combined with the regenerators" (previously described as low temperature condensation units, i.e., air liquefaction plants). The heading for the portion of the Kahle disclosure relied on by defendants is, in and of itself, revealing: "Exchange of Energy and Matter in Adsorbers *Combined* with Regenerators"<sup>2</sup> (emphasis added). It clearly conflicts with the Skarstrom process being a "self-contained, self-regenerating gaseous fractionation process" as called for in the agreed upon summary appearing on page 7 of defendants' brief (and pages 13-14 of plaintiff's brief).

Specifically rebutting defendants' further assertions on pages 16 to 21 of their brief, the following should be noted:

1. It was defendants who apparently felt the need to rely on the ten items of prior art before the Trial Court. This is clearly inconsistent with their present assertion that the three Kahle references are all that is required to show unpatentability.

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1. It was the allowance of this German patent application which prompted the opposition referred to on pages 17 and 18 of the lower Court's decision, App. 53a-54a.

2. PX 5F p. E-74.

2. If the three Kahle publications referred to<sup>1</sup> so clearly teach the Skarstrom process, how can one explain that Kahle himself, who had worked in this field for some 20 years, nevertheless at no time made the required, admittedly novel, combination of features? Why had not Kahle developed a "heaterless drier" and licensed it worldwide?

*The simple answer is that the combination was unobvious, even to a highly skilled researcher such as Kahle.*

3. Plaintiff's comments as to "size" merely illustrate that the Skarstrom invention produces a self-contained self-regenerating drier, i.e., one that can be "plugged in" and made to work without requiring extraneous units such as Kahle's air liquefaction plants. That heat-regenerated driers (heater-type driers) were examples of prior "plug in" systems was clearly acknowledged on pages 5, 7 and 22 of plaintiff's brief. Skarstrom's heaterless-type process, however, offered significant advantages over such systems.

4. Defendants' piecemeal utilization of the prior art is well illustrated by the contentions on pages 18 and 19 of their brief. The sentence from the 1953 Kahle article quoted on page 19 of the defendants' brief regarding use of part of a product gas as purge gas relates to the system shown in Figure 7<sup>2</sup> of the reference which employs a *heater* for heating the purge gas as well as a cooler for cooling the feed gas to the system—a system basically opposed to Skarstrom's heaterless drier. This Kahle system is quite similar to a heat regenerated type drier system (Trinity drier) clearly recognized by plaintiff to be well known in the art and discussed in some detail on pages 25 to 27 of plaintiff's brief.

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1. German Patents 871,886, 970,223 and the 1953 Article (PX 5B, 5D and 5F, respectively).

2. Referred to by Kahle as the Sorbogen II Process.

As to whether Professor Meissner's testimony that Kahle contemplated the use of the output of an air liquefaction plant for purge gas, *i.e.* whether the German word "Zerlegungsprodukt" as used in the references so indicate,<sup>1</sup> plaintiff is pleased to aid defendants and direct their attention to the following testimony. Professor Meissner testified (App. 145a-147a) that page 2, paragraph (a) of German Patent 871,886 (PX 5B) used the word "fractionation product" as the fractionation product derived from the rest of the plant, presumably the liquid air plant. It is this paragraph in the German patent text (p. E-24) which uses the German word "Zerlegungsprodukt" (which was set forth as "fractionation product" in the translation, p. E-28).

That Professor Meissner's testimony was clearly to this effect is confirmed by defendants' own expert witness Prutzman on his cross-examination (App. 272a-274a):

"Q. Do you recall Dr. Meissner's testimony that this word in German as used in this patent is translated as the fractionation product from the liquid air plant? A. Yes, I recall that." (App. 273a)

## POINT II

### **The Trial Court Erred in Holding Skarstrom Did Not Produce Unexpected Results.**

Contrary to defendants' brief, page 22, the principal thrust of plaintiff's position on this point is that there is nothing in the prior art, *i.e.* the Trinity heated-type drier, nor the Kahle references, which would lead one to expect that the combination of features of the Skarstrom invention would enable one to achieve a degree of dryness *well beyond* these prior art systems, *i.e.* the ability to superdry

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1. Page 19 of defendants' brief.

air to a dryness level of only a fraction of one part per million of water—less than 1/100 of a percent or 100,000 times drier than typical room air (App. 84a).

Defendants have not pointed to *any disclosure* in the Kahle references that would have taught that the Skarstrom combination of features would have given such *markedly* improved drying ability.

Indeed, *none* of the Kahle references relied on was designed to act as a drier. Nowhere have defendants quoted a *portion* of these references illustrating their use as a drier, or what resultant drying effect was obtained.

In contrast, Professor Meissner testified that in comparison with the Skarstrom invention the Kahle system (if converted to use as a drier) would reduce ambient air from 7,000 ppm moisture level to 2,000 ppm rather than to a level of under 20 ppm as obtained during the courtroom demonstration of the Skarstrom invention. His testimony was uncontroverted by defendants (plaintiff's brief, page 16; App. 191a).

It was this remarkable new ability offered by the Skarstrom invention that prompted its almost immediate use in America's space program, thereby enabling the initial launching of the Vanguard missile (App. 232a-233a). A broken-down standard heated drier was made to operate in an entirely new manner to give better drying than Dr. Skarstrom and others had ever obtained from commercial driers.

*There is nothing in the Kahle references to lead one to expect such would be the case nor indeed did the Kahle system give such results.*

In addition to the above, the fact that various people skilled in the art were surprised that the Skarstrom invention would even work let alone give such markedly improved results is indicative of the unobvious nature of the Skarstrom process.

Absent any evidence to the contrary, one must assume that those working and teaching in the field for years would have a knowledge of the prior art (as is indeed premised by the patent statutes).<sup>1</sup> Certainly the reaction of surprise and incredulity by skilled engineers, scientists and professors should not be dismissed in determining what was "unexpected to one skilled in the art."

Thus we find that:

—Dr. Skarstrom, a PhD physicist of some 27 years industrial experience was totally surprised.

—The personnel of Trinity Equipment, plaintiff's initial licensee, who had manufactured heated-type driers for a number of years and were familiar with industrial practice, were surprised.

—The engineers at the numerous customers who were approached initially by Trinity refused to believe that the Skarstrom process would work and required "see-through" glass models to overcome their disbelief (App. 229a-230a).

Plaintiff finds nothing in the cross-examination of Professor Meissner relative to the Kahle prior art which "removed his surprise and skepticism" (pages 23 and 24 of the defendants' brief). Indeed, the import of Professor Meissner's testimony was that *after* carefully reviewing all the Kahle literature including the three Kahle references referred to on page 10 of the defendants' brief, he found that the Skarstrom invention was *unobvious* over the prior art.

Indeed, Professor Meissner testified that Skarstrom distinguished over the prior art by:

(1) Utilizing "a single gas stream under pressure, supply[ing] no other forms of energy, and produc[ing] out of that device a purge stream and a product." (App. 137a)

1. There is also the question of whether references (Kahle) concerned with an integrated adsorber for removal of carbon-dioxide from air fed to an air liquefaction plant would represent relevant prior art to those seeking a self-contained, "plug-in" drier.

(2) That he was still surprised that the Skarstrom process could work.

"It is the fact that he can split that product stream out of the adsorber into two parts and use one part to purge the adsorber which is being desorbed, which is on the regeneration cycle, and still have gas left over, which to me was very surprising when I first encountered the circumstance. I would have, instead, expected that a much larger quantity of purge gas would have to be used. And indeed until I saw the apparatus actually operated I must confess I was somewhat skeptical about the success before I saw the Skarstrom apparatus demonstrated." (App. 127a)

(3) That in Kahle,<sup>1</sup> "Unlike Skarstrom, the purge gas does not come from the product gas made within the process itself, but instead the product gas comes from another part" of the process, i.e., presumably the air liquefaction plant (App. 147a).

The fact that while Professor Meissner both in direct examination and in cross-examination found *individual* features of the Skarstrom process in the Kahle references did not in his opinion as an expert (and full professor at MIT for over 20 years) make the Skarstrom process obvious.

In sum, then, neither the lower Court's opinion, the trial record, nor defendants' brief has pointed to any disclosure in the prior art which:

- (1) Would teach means for superdrying of air to a moisture level of a fraction of a part per million (considerably below the level obtained by the prior art heated-type driers, or the Kahle type of system even if used as a drier).
- (2) Would have led one to expect that the Skarstrom process would have been able to operate without

1. German Patent 871,886 (PX 5B, p. E-23).

the use of heaters, coolers or an external supply of purge gas.

*This indeed proves that unexpected results were obtained.*

### POINT III

#### **The Trial Court Misinterpreted the Significance of Boyle's Law and Dalton's Law.**

With reference to pages 26 and 27 of defendants' brief, there appears to be no dispute as to the definition of Boyle's law and Dalton's law (page 35 of plaintiff's brief); nor indeed that both these laws relate to behavior of gases relative to pressure and *not* adsorption of gases on solids. Quoting from defendants' brief (page 27) "The gas laws were not explained to the trial court in the context of explaining why adsorption occurs." They accordingly could not have been used for explaining why the reversal of adsorption, i.e., desorption, occurs; nor do they teach the conditions necessary for desorption.

Thus, such laws on gas-pressure behavior certainly could not have taught one the unique Skarstrom *adsorption* process which was in conflict with the prior art use of heaters and/or excess of extraneous purge gas for desorption.

These laws are of course well known to high school students. However, the fact that numerous people skilled in the art having knowledge of these laws nevertheless found the Skarstrom process to be surprising is evidence of the clearest type that these laws, per se, do not teach the Skarstrom invention.

## POINT IV

### Use of German Opposition Claim Improper.

The simple fact is that in order to interpret a claim from a German patent application, one must know something about German claim practice and German law regarding claim interpretation. Both are essential elements of German Patent Law which must be established before one can interpret a German claim. Yet *no testimony* was taken as to German claim practice. A translation of the German patent claim in opposition was all that was placed in the record.

Both parties agree that the issue of *patentability* under German Patent Law is irrelevant. However, that is not the point. Rather it is the lack of any proof of present German Patent Law (in 1973) as to the *interpretation* of a German patent claim (introduced in 1972) which is a clear failing in the record.<sup>1</sup>

How can one speak of admission when one has not established the interpretation of this specific German patent claim under German patent law?

The lower Court's use of the German claim to establish unpatentability is particularly inappropriate where plaintiff has taken the position that the present invention deals with a combination of features, no one of which is necessarily new, *per se*. How then can a theorized view of plaintiff's position as to any one feature in a German patent claim be determinative of patentability in the United States?

Plaintiff is not retreating from its stipulation but rather illustrating that it is of no significance to the decision in

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1. At most, the lower Court (page 18 of the decision, App. 54a) refers to communications between plaintiff and its German patent agent in 1965 as to a different claim. This correspondence did not, however, relate to the German claim referred to in the decision.

this case. The alleged "admission" is certainly no greater than plaintiff's continued indication throughout its brief that the test to be applied in the present case is: assuming each individual feature is individually known, was the combination nevertheless patentable?

In fact, the Trial Court's interpretation of the German claim is inconsistent with German Law. As indicated on pages 42 and 43 of plaintiff's brief, the form of the German claim is totally *insignificant* in itself as to the determination of the definition of invention. The quoted German text article states that:

"If the invention resides in a combination, the patent-sustaining feature may be seen in an element (or step) recited in the preamble . . . The fact that one or the other feature is recited in the characterizing clause does not prove it represents the inventive feature . . . The fact that an element or step of a combination is recited in the preamble does not mean that it is insignificant to the total combination." (Plaintiff's Brief, pp. 43-44)

Accordingly, the analysis made on pages 18 to 20 of the lower Court's opinion (App. 54a-57a) is in conflict with German claim practice.

## POINT V

### **The Trial Court Misapplied Test of Supreme Court as to Standard of Patentability.**

With reference to pages 30 and 31 of defendants' brief, since the Trial Court apparently placed significant weight on the decision in the A & P case,<sup>1</sup> it must be assumed that it applied the "genius test" of the A & P decision, which is clearly not the present law due to the subsequent enactment of the 1952 Patent Act.

1. *A & P Tea v. Supermarket Corp.*, 340 U.S. 147, 154-155 (1950).

### Summary

This Court's decision in *Shaw v. E. B. & A. C. Whiting Company*, 417 F.2d 1097 (1969), relied on by defendants on pages 20 and 21 of their brief, is indeed pertinent to the review of the lower Court's holding in this case. In the *Shaw* decision this Court said:

"However, the fact that each element of a creation sought to be patented is found in the prior art does not negate novelty if the old elements are combined in such a way that as a result of the combining an improved, useful, and more advantageous innovation is obtained." (Page 1101)

"The ultimate question of obviousness is one of law..." (Page 1102)

"The mere recital of the known elements in the art does not, without more, invalidate the patent under Section 103. There must appear evidence that the *bringing together* of these elements would have been obvious. Doubt as to validity, no matter how strong, cannot justify resort to unfounded assumptions or supply deficiencies in the factual background. *Graham v. John Deere Co.*" (Pages 1104 and 1105)

While mindful that a District Judge's findings of fact should not be upset "unless clearly erroneous," this Court further stated that:

"... we believe that the trial court failed adequately to resolve the factual inquiries required by *Graham*, quoted *supra*, in particular, 'the scope and content of the prior art' and 'the level of ordinary skill in the pertinent art' by ignoring an abundance of unchallenged uncontroverted evidence in the record which tends to demonstrate that Shaw's patent was not obvious." (Page 1103)

This Court went on to further caution against the use of "hindsight" as applied by the lower Court in finding that Shaw did not obtain an "unexpected result."

"In resolving the question of obviousness, the judicial view must not include the knowledge contributed by the patentee; the teachings of his patent are irrelevant when determining what 'would have been obvious' to one skilled in the prior art before he created his 'manufacture.'" (Page 1105)

All of the foregoing criteria are applicable to the present case, and would clearly indicate that the Skarstrom process gave unexpected results and was unobvious over the prior art.

### Conclusion

The District Court should have enforced plaintiff-appellant's patent. Accordingly, it is submitted that the judgment of the District Court dismissing the Complaint on the basis of invalidity of the Skarstrom Patent U.S. 2,944,627, should be reversed, and the patent judged valid, and the case remanded to the District Court for the determination of the issue of damages.

Respectfully submitted,

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